

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Anthony G. Macaluso	Art Unit:	2617
Serial No.:	10/809,922	Examiner:	Matthew C. Sams
Filed:	March 24, 2004	Conf. No.:	6755
Title:	ADVERTISING ON MOBILE DEVICES		

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Pursuant to 37 C.F.R. § 41.41, Applicant responds to the Examiner's Answer as follows

Examiner continues to apply an overbroad interpretation of claims 1, 17, 34

As clearly outlined in the Appeal Brief (see pages 7-8), claim 1 recites "selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time." (Emphasis added.) The claimed "determined time" is the time required to complete the wireless communication, such as downloading a file. An advertisement is selected to present to the user only if that determined time is longer than the threshold time.

The Examiner concedes that "Sakoda does not explicitly recite selecting an advertisement if the determined time is longer than a threshold time." (See Examiner Answer at page 15.) Then the Examiner continues misapply the teachings of Van Erlach to Sakoda.

Specifically, Examiner continues to cite to irrelevant portions of Van Erlach that fail to address the claimed limitations at issue. The Examiner contends that Van Erlach teaches that "ads are selected from a database on an ad server whose designated target audience, time slot, television show characteristics and other parameters match those of input (Page 2 [0011]) which leads one of ordinary skill in the art to recognize that one of the selection criteria in determining which ad to show is based on the amount of time available in the time slot." (Internal quotations removed. See *id.* at page 16.) The Examiner further contends that "Van Erlach includes the additional ability to compress or alternatively decompress ads so that they can be made to fit into the available time slot." (See *id.*) Based these two alleged teachings of Van Erlach, The Examiner incorrectly concludes that "Van Erlach teaches the ability to select a stored advertisement that has a runtime that is longer than the time slot and an advanced ability not claimed by the Appellant of being able to adjust the runtime of the advertisement to more closely equal the time slot." (See *id.*)

However, as addressed in the Appeal Brief, the selection criteria in Van Erlach related to the time slot is irrelevant to the claimed limitation. Claim 1 does not recite fitting an ad into a time slot or selecting an ad into a time slot. Rather, claim 1 recites selection of an ad that is dependent on the occurrence of a condition (if the determined time is longer than a threshold time.) In other words, the time required to complete the communication must be longer than a threshold time before an ad is selected for presentation to the user. This makes sense because an ad cannot be presented to the user if the time required to complete the communication is longer than the time needed to present the ad to the user. Thus, the claimed selection of the ad is conditioned upon the determined time being longer than a threshold time.

In contrast to claim 1, Van Erlach describes a completely different approach. First, the "time slot" in Van Erlach does not describe a time to complete a communication. Thus, anything done in relation to the "time slot" in Van Erlach is inapplicable to the claimed time required to complete the wireless communication. Also, as identified by the Examiner, Van Erlach describes "compressing" or "decompressing" the ad to "fit" into the "time slot." Thus, Van Erlach describes modifying the ad to fit into the time slot and does not select an ad that fits the time slot.

Moreover, the Examiner contradicts himself. It is unreasonable to contend that Van Erlach selects an ad based on the "time slot" when Van Erlach teaches modifying the ad to "fit" into the time slot.

Then, the Examiner contends that the "time slot" in Van Erlach is equivalent to the claimed "threshold time" and the ability to modify the ad's runtime to fit the time slot is the claimed "time required to complete the wireless communication." (See id. at page 16.)

The Examiner views Van Erlach's time slot (which has a fixed time length) as equating to the "threshold time" (which is a fixed time that is long enough to run an advertisement) and the ability to compress or decompress the ad's runtime to fit and fill the time slot as equating to the "determined time", which can be longer than the time slot since the ad's runtime might have to be compressed in time. Further, the analogy also fits if the "determined time" is equated to the time slot and the ad's runtime is equated to the "threshold time", since Van Erlach teaches that an ad's runtime can be decompressed to fill the time slot (i.e. the determined time is longer than the threshold time because the time slot is longer than the ad's runtime). The Examiner is not stating that Van Erlach is "determining a time required to complete the wireless communication", since that is taught by Sakoda as explained above.

(See id.)

However, this is factually and technically illogical. First, it is unreasonable to equate the ability to compress and decompress the ad in Van Erlach as the claimed time required to complete the wireless communication. Compressing and decompressing an ad in Van Erlach is a function of

modifying the ad, which is unrelated to any time duration let alone the claimed time to complete the wireless communication. Also, the "time slot" in Van Erlach cannot reasonably be the claimed threshold time because Van Erlach does not use the "time slot" as a condition for selecting an ad.

In fact, if the Examiner's contentions were correct, we should be able to substitute the "time slot" and "ability to compress or decompress the ad" in Van Erlach for the claimed "threshold time" and "determined time" in claim 1 and obtain a reasonably same scope as the claimed limitation. However, such substitution results in an incomprehensible claim construction: "selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the [ability to compress or decompress the ad] is longer than [the time slot]." This is not surprising because Van Erlach does not select an ad based on any condition. As detailed in the Appeal Brief, Van Erlach modifies the ad ALREADY SELECTED to "fit" the time slot.

In continuing the unreasonable application of Van Erlach, the Examiner concludes without any support in Van Erlach, Sakoda or any other cited art that Van Erlach would not try to compress or decompress the ad too much. (See *id.* at pages 16-17.)

Further, the Examiner believes that it is well within the scope of one of ordinary skill in the art to recognize that if the advertisement's runtime is much longer than the available time slot and would not be an effective advertisement even when compressed (because too much information would have to be cut), that the intelligent router in Van Erlach would not try to compress the advertisement and would instead search for another advertisement to display. The Examiner believes it is well within the scope of one of ordinary skill to recognize that the amount of compression and decompression that can occur to an advertisement would have an upper and lower boundary in order to still be an effective advertisement.

(See *id.*)

However, nothing in Van Erlach suggests this. What is clear is that Van Erlach does not select an ad based on the time slot but rather modifies an ALREADY SELECTED ad to fit the time slot.

In addition, the Examiner incorrectly contends that the claimed “selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication” is not positively recited. The Examiner reasons that this is because the claimed selection is based upon the “if...” condition. (See *id.* at page 17.)

As a separate point, the Examiner believes “selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication” is not a positive recitation of the limitation because the stored advertisement is selected “if the determined time is longer than a threshold time”. Further, the Appellant argues that “Only if that determined time is longer than the threshold time, is an advertisement selected” (Page 8), however the claim does not recite “only if”. The Examiner believes the Appellant is improperly interpreting the claims too narrowly.

(See *id.*)

However, the Examiner provides no legal basis to support the contention. The Examiner is not allowed to ignore words in the claim without providing an appropriate legal basis. In fact, MPEP strictly requires that all words in a claim must be considered. (MPEP 2143.03).

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Moreover, the “if...” condition does not render the entire claim limitation void. Instead, the “if...” condition provides a condition precedent for the claimed “selection” to occur. Moreover, even if the Examiner is correct to interpret the “if...” condition to be not equal to an “only if” condition, the Examiner is still incorrect to completely ignore the limitation.

Also, the Examiner contends that the Examiner’s position is clear because the *Van Erlach* teaches compressing the ad if longer than the time slot and decompressing the ad if shorter than the time slot (See *id.* at pages 17-18). This contention misses the issue at hand. As described above, equating the “time slot” and “ability to compress or decompress the ad” in *Van Erlach* to the claimed “threshold time” and the “determined time” respectively is illogical and incomprehensible because they are not equivalent. Moreover, substituting those elements in *Van Erlach* into the claims renders the claims incomprehensible.

Next, the Examiner continues to contend that Sakoda teaches the claimed “presenting one or more of a rotation of the stored advertisements.” (See *id.* at page 18). However, this is not the entirety of the claimed limitation. Claim 34 recites “presenting one or more of a rotation of the stored advertisements on the mobile device during the period of delay in the wireless communication session if the determined time is longer than a threshold time.” (Emphasis added.) As an initial matter, the combination of Sakoda and Van Erlach fails to teach or suggest performing the claimed “presenting” based on the “if...” condition. This is because, similar to claim 1 above, the “time slot” and the “ability to compress or decompress an ad” in Van Erlach are irrelevant to the claimed limitations.

In addition, the Examiner misinterprets and misapplies Sakoda when contending that Sakoda teaches that “the successively viewed advertisements, that is, the advertisements viewed during initialization of the terminal 30_j and the advertisement viewed during the waiting time for downloading in the example shown in Fig. 5.” (See *id.* at page 18.) Sakoda does not teach that at least one full rotation of ads are presented “during the period of delay in the wireless communication session if the determined time is longer than a threshold time” as recited in claim 34. Rather, Sakoda merely teaches that the advertisement displayed during initialization of 30-j terminal is different from the advertisement displayed during the waiting time for downloading. This is because Sakoda teaches selecting an advertisement from a plurality of advertisements based on “[t]he 30-j assign[ing] priorities to the advertisements.” (See Sakoda at column 10, lines 55-62.) Selecting an advertisement based on an assigned priority is irrelevant to presenting one or more rotation of ads “during the period of delay in the wireless communication session if the determined time is longer than a threshold time” as recited in claim 34.

The Examiner then contends that the Applicant is taking a piecemeal analysis of the reference when contending that “priorities assigned in Sakoda are not based on the above claimed condition of “if the determined time is longer than a threshold time.” (See Examiner’s Answer at page 18.) The Examiner reasons that the “Examiner is relying upon Van Erlach to teach that ads are selected based on the time available in the time slot and other parameters matching the user’s interest, (Page 2 [0011]) which leads one of ordinary skill in the art to recognize that one of the selection criteria in determining which ad to show is based on the amount of time available in the time slot.” (See *id.* at page 19. Internal quotations removed.)

However, this is faulty reasoning because as detailed above with respect to claim 1, the “time slot” and the “ability to compress or decompress the ad” in Van Erlach are unrelated to the claimed limitations. This is because Van Erlach teaches modifying an ad to fit the time slot rather than selecting an ad based on the time slot.

The boot up and wake up process in Hamano are inapplicable to claim 26

As outlined in the Appeal Brief, the boot up and wake up process in Hamano are not related to any wireless communication, and thus the ads in Hamano are not displayed “during at least a portion of the wireless communication....” Also, the boot up process in Hamano does not include the claimed “wherein the advertising application on a mobile device presents the new advertisement during the delay if the delay is longer than a threshold time.”

In response, the Examiner contends that Hamano is not relied upon to reject these limitations. Instead, the Examiner contends that he is relying on Val Erlach's teachings of the “time slot” and the “ability to compress or decompress the ad.” (See id. at pages 19-20.) Thus, as an initial matter, Examiner appears to concede that Hamano fails to teach these limitations. This is not surprising because Hamano teaches a boot up process which is unrelated to completing a wireless communication.

Moreover, similar to the discussion regarding claim 1, the “time slot” and “ability to compress or decompress the ad” in Van Erlach are unrelated to the claimed condition of “if the delay is longer than a threshold time.” For example, the “ability to compress or decompress the ad” is not a time duration equivalent to the claimed “delay.”

Further, the Examiner contends that the “the advertising application on a mobile device presents the new advertisement during the delay” and the “transmit a selected new advertisement to the mobile device” are not positive recitation of the limitation because the limitations are dependent on an “if...” condition. (See id. at pages 20-21). As described with respect to claim 1 above, such contentions are unsupported and incorrect because the Examiner has a duty to consider every word in the claim.

For these reasons, and the reasons stated in the Appeal Brief, Applicant submits that the final rejection should be reversed.

Applicant: Anthony G. Macaluso
Serial No.: 10/809,922
Filed: March 24, 2004
Page: 7

Attorney's Docket No.: 13817-0006001

CONCLUSION

The foregoing comments made with respect to the positions taken by the Examiner are not to be construed as acquiescence with other positions of the Examiner that have not been explicitly contested. Accordingly, the above arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: July 15, 2009

/Hwa C. Lee/
Hwa C. Lee
Reg. No. 59,747

Fish & Richardson P.C.
12390 El Camino Real
San Diego, California 92130
Telephone: (858) 678-5070
Facsimile: (877) 769-7945

HCL/jhg
10932746.doc